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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/843,126	04/26/2001	Peter C. Astles	CA2413US NP	8340

5487 7590 09/09/2002

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EXAMINER

CHANG, CELIA C

ART UNIT	PAPER NUMBER
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1625

DATE MAILED: 09/09/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/843,126

Applicant(s)
Astles et al.

Examiner
Celia Chang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jul 3, 2002
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-72 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-72 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:

- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. _____.
- ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- ☐ Interview Summary (PTO-413) Paper No(s). _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

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DETAILED ACTION

1. Claims 1-72 are in the case.

2. *Restriction*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 36-50, 52, drawn to piperidinyl compounds and compositions, classified in class 546, subclass various depending on species election. If this group is a further election of a single disclosed species is also required. If this group is elected generic claims 1-35, 50, 53-54 can be prosecuted together with the elected compound, claims 55-63 can be prosecuted together with the elected compound to the extend of the election upon election of a single disclosed condition/disease i.e. one disease of claim 56 or 57.
- II. Claims 1-35, 51, 53-54 excluding piperidinyl compounds of group I, drawn to remaining compounds and compositions, classified in class 540, 546 or 548, subclass various depending on species election. If this group is a further election of a single disclosed species is also required. If this group is elected method claims 55-63 can be prosecuted together with the elected compound to the extend of the election upon election of a single disclosed condition/disease i.e. one disease of claim 56 or 57.
- III. Claims 55-63, drawn to method of treating diseases, classified in class 514, subclass various, depending on species election. If this group is elected, a further election of a single active ingredient for treating a single disorder i.e. one among claims 56-57, is also required.
- IV. Claims 64-72, drawn to composition and method of using multiple active ingredient for treating disorder, classified in class 514, subclass various, depending on species election. If this group is elected a further election of a single disclosed combination of active ingredient and its treating of a single

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disclosed disorder is also required. Further restriction will be made among the different classes of combinations after election.

The inventions are distinct, each from the other because:

Groups I and II are distinct because the compounds of group I and group II differ in elements, bonding arrangements and chemical properties to such an extent that a reference anticipating compounds of group I would not necessarily render compounds of group II obvious. The search for compounds of group I is not required for group II and vice versa. The method of treatment of group III is independent and distinct because method of treating the independent and distinct disease for example asthma and ulcer are disease and symptom oriented. Each method must be searched examined on its merit. The composition and method of treatment using multiple active ingredients of group IV are independent since the combination can be synergistic, parallel or in independent functionality (see CA 110, CA132). The basis for merit examination and searches of such distinct combination are not coextensive thus separate examinations must be conducted.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Should applicant traverse on the ground that the groups and species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the groups and species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention. In the instant case then there could have been no patentability of all the claims over Pieper et al. CA 122.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the

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application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Celia Chang whose telephone number is 703-308-4702. The examiner can normally be reached on Monday through Thursday from 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alan Rotman, can be reached on (703) 308-4698. The fax phone number for the organization where this application or proceeding is assigned is 703-308-7922.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

WP/Chang

Sept. 5, 2002



Celia Chang

Primary Examiner

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